

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No. 7,455,987

Issued: November 25, 2008

Inventors: PAUL HABERMANN, et al.

Application No.: 09/664,326

Filed: September 18, 2000

For: SIGNAL SEQUENCES FOR PREPARING
LEU-HIRUDIN BY SECRETION BY E.COLI INTO
THE CULTURE MEDIUM

Group Art Unit: 1652

Examiner: Tekchand SAIDHA

Confirmation No.: 4393

Mail Stop Patent Extension

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

POST GRANT APPLICATION FOR PATENT TERM ADJUSTMENT

1. Facts

The Office issued the subject U.S. Patent No. 7,455,987 ("the '987 patent") with a patent term adjustment of 737 days. The Application was filed on September 18, 2000. A Restriction Requirement dated March 27, 2002, was the first Office Action on the application, creating a U.S. Patent and Trademark Office (PTO) delay of 129 days. A response to the March 27, 2002, Restriction Requirement was filed on April 26, 2002. A subsequent non-final Office Action was mailed on June 27, 2002. A response to the June 27, 2002, Office Action was filed on October 15, 2002, creating an Applicant delay of 18 days. A final Office Action was mailed on January 7, 2003. A response to the January 7, 2003, Office Action was filed on April 7, 2003. An Advisory Action was

mailed on April 24, 2003, and a Notice of Appeal was filed on July 7, 2003, creating an Applicant delay of 91 days with respect to the final Office Action of January 7, 2003.

An appeal brief was filed on October 24, 2004, and an Examiner's answer was mailed on January 26, 2004. A reply brief was filed on March 19, 2004. A Request for Continued Examination was subsequently filed on July 15, 2005. A non-final Office Action was mailed on December 29, 2005, creating a PTO delay of 45 days. A response to the Office Action of December 29, 2005, was filed on March 16, 2006. A final Office Action was mailed on May 30, 2006.

A notice of Appeal was filed on August 24, 2006, along with a pre-appeal conference request. The decision on the pre-appeal conference request was mailed on October 6, 2006. An appeal brief was filed on February 15, 2007, and an Examiner's answer was mailed on July 17, 2007. A reply brief was filed on September 13, 2007. The decision from the Board of Appeals and Interferences reversing all of the Examiner's rejections was mailed on June 25, 2008. This created a PTO delay of 672 days with respect to the notice of appeal filed on August 24, 2006.

The application was allowed on July 18, 2008, and the issue fee was paid on October 17, 2008. The '987 patent issued on November 25, 2008.

2. Calculation of Patent Term Adjustment

The three year pendency date for the determination of patent term adjustment ("PTA") is September 18, 2003. Therefore, within three years of the filing date, there was a delay of 109 days on the part of the Applicant (18 days + 91 days) and a delay of

129 days on the part of the PTO, which corresponds to a net delay of 20 days on the part of the PTO occurring within three years of the filing date of the application.

This application is entitled to PTA due to the three-year pendency rule from the three year pendency date of September 18, 2003, to the date a Request for Continued Examination was filed on July 15, 2005. This corresponds to a PTO delay of 666 days. This time period from September 18, 2003, to July 15, 2005, did not overlap with any other period of PTA-related PTO delays.

Additional PTA is available to this application due to the delay of the PTO in responding to the Request for Continued Examination of July 15, 2005. As mentioned before, this period corresponds to 45 days. Also mentioned above, the PTA available due to a successful appeal in this application is 672 days.

Therefore, in view of the decision of the Federal District Court for the District of Columbia in *Wyeth v. Dudas* on September 30, 2008, the patentee is entitled to a total patent term adjustment of 1403 days, which is the sum of: a) 20 days due to a net PTO delay in prosecution before the three-year deadline after filing; b) 666 days due to exceeding three year pendency; c) 45 days due to failing to respond within four months to the Request for Continued Examination of July 15, 2005; and d) 672 days due to a successful appeal. None of these periods overlap with each other.

Customer No. 22,852
U.S. Patent No.: 7,455,987
Attorney Docket No. 02481.1693.00000

If there are any fees due in connection with the filing of this request, please
charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 23, 2009

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